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February 21, 2006

TO: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 3729 - Examiner Tugbang, Anthony D

FROM: George O. Saile, Reg. No. 19,572
28 Davis Avenue
Poughkeepsie, N.Y. 12603

SUBJECT: Serial #: 10/706,838
File Date: 11/12/2003
Inventor: Jei-Wei Chang
Examiner: Tugbang, Anthony D
Art Unit: 3729
Title: Narrow Track CPP Head with Bias Cancellation

RECEIVED 11/12/2003

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated Jan. 18, 2006. In that office action, restriction was required to one of the following Inventions under

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on Feb. 21, 2006.

Signature: Stephen B. Ackerman Date: Feb. 21, 2006
Stephen B. Ackerman, Reg. No. 37,761

35 U.S.C. 121:

The inventions stated are:

I - Claims 1-16, drawn to a process of making a magnetic head, classified in class 29, subclass 603.07, and

II - Claims 17-32, drawn to a product of a magnetic head, classified in class 360, subclass 324.12.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1-16 drawn to a process classified in Class 29, subclass 603.07. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I and II as (1) that the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a method of

forming "a method to increase GMR signal strength", and that the product claims are directed to "a GMR stack", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass 29/603.07 and product class/subclass 360/324.12, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "the product of Group II can be made by a materially different method, such as one that patterns a bias cancellation layer by shear coating without removing of any portions of the bias cancellation layer or without the need for a mask" is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the cost additional patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Restriction was also required to one of the following Inventions under 35 U.S.C. 121:

The inventions stated are:

I - Claims 1-6, drawn to a method of process of making a magnetic head that includes depositing an upper lead layer, classified in class 29, subclass 603.13, and

II - Claims 7-16, drawn to a process of making a magnetic head that includes covering magnetic layers and removed portions of a bias cancellation layer with a layer of insulation, classified in class 29, subclass 603.2.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1-6, drawn to a process classified in Class 29, subclass 603.13. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner states that Inventions I and II are related as combination and subcombination, and gives as the reasons for distinctness that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. \perp 806.05(c)). However, upon reading the Invention II Claims against the Claims of Invention I, it can be seen that Invention II is drawn to "a process to manufacture a CPP magnetic read head", while Invention I is drawn to "a method to increase GMR signal strength". As

such, the field of search must necessarily cover both the Group I class/subclass 29/603.13 and the Group II class/subclass 29/603.2, in addition to other related Classes and subclasses to provide a complete and adequate search. The fields of search for the Group I and Group II inventions are clearly and necessarily co-extensive. The Examiner's suggestion that "combination (Group 1-A) also has a separately usable process of depositing an upper lead layer", among others, is speculative and has nothing to do with the Claims as presented in this patent application.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,



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